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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPT.
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER	
CHANG, SUNRAY	

ART UNIT	PAPER NUMBER
2121	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/763,786	FISCHER ET AL.	
	Examiner	Art Unit	
	Sunray Chang	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in responsive to the paper filed on November 29th, 2006.

Claims 1 – 14 are presented for examination.

Claims 1 – 14 are rejected.

Priority

2. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in EPO, 01119041.0 [08/07/2001], in chain by PCT/EP02/08352 on July 26th, 2002. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application in chain by the PCT, since the PCT was filed more than seventeen months before current application thereafter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. **Claims 1, 2, 4, 7 – 9, 11 and 14 are rejected** under 35 U.S.C. 102(b) as being anticipated by Barry Omshehe et al. (U.S. P.G. Pub. No. 2002/0069172, and referred to as **Omshehe** hereinafter).

Regarding independent claim 1, Omshehe teaches,

- A process control system, [a manufacturing/process control network, Fig. 1, 0014 and 0031] comprising:
- A processor [a portal server, 0011, 0014 and 0031; Fig. 1] adapted to determine a payment figure [fairly charging customers, 0011] from operation running in the process control system regarding the creation **or** removal of a process control function **or** regarding a user activity **or** regarding an execution of an automation function. [0011]

Regarding dependent claim 2, Omshehe teaches,

A process control system according to claim 1, further comprising:

- a process control computer; [portal server, Fig. 1, 0031; a portal site is an Internet site that provides access to a variety of information from potentially many sources, 0008]
- a client computer; [remote work stations, Fig. 1, 0031; users generally access the portal site via remote computers executing general browser software, 0008] and

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- the Internet [60, Fig. 1], wherein at least a part of the operations running in the process control system run on the process control computer. [a portal server receives an access request to a resource for which a license is required, 0011]

Regarding dependent claims 4 and 8, Omshehe teaches,

A process control system according to claim 2, wherein

- the process control computer comprises a Web server [portal server, Fig. 1, 0031; a portal site is an Internet site that provides access to a variety of information from potentially many sources, 0008] and
- the client computer comprises an Internet browser [remote work stations, Fig. 1, 0031; users generally access the portal site via remote computers executing general browser software, 0008] so that
- the client computer can influence the operations running in the process control computer via the Internet, [a portal server approach to accessing process control information/resources is the ability of users to gain access from virtually any location in the world ... to obtain access to and provide supervisory services without having to physically present on the manufacturing/industrial plant, 0010] wherein
- the operations can also include operations by which further operations are initiated in further components of the process control system. [enables centralized, coordinated, and highly integrated control of an enterprise, 0010]

Regarding dependent claims 7, 9 and 11, Omshehe teaches,

A process control system according to claim 1, wherein

- the payment figure is a service fee to be paid by the user of the process control system to an Application Service Provider. [properly charging customers for their use of such portal services, 0010; a new way to monitor and regular access by users to manufacturing/process control portal services, 0011]

Regarding independent claim 14, Omshehe teaches,

- A method for determining a payment figure [fairly charging customers, 0011] in a process control system [a manufacturing/process control network, Fig. 1, 0014 and 0031], comprising:
 - providing a processor unit [a portal server, 0011, 0014 and 0031; Fig. 1] adapted to record the creation and/or removal of a process control function and an execution of an automation function; [display historical license usage information, 0033]
 - providing a device adapted to record a user activity; [display historical license usage information, 0033] and
 - determining a payment figure [fairly charging customers, 0011] by the processor unit using recorded data of the preceding steps. [display historical license usage information, 0033]

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 3, 5, 6, 10, 12 and 13 are rejected** under 35 U.S.C. 103(a) as being unpatentable over **Omshehe**, and in view of Andrew G. Swales et al. (U.S. Patent No. 6,233,626, and referred to as **Swales** hereinafter).

Regarding Claim 3

Omshehe teaches,

- at least one field device for automation of at least one system component [such control processors and programs support a substantially self-running industrial process (once set points are established), 0004] wherein
- at least a part of the operations running in the process control system run on the field device. [Improvements to process control technology have enabled vastly larger and more complex industrial processes to be controlled via programmed control processors. Control processors execute control programs that read process status variables and execute control algorithms based upon the status variable data and desired set point information to render output values for the control points in industrial processes, 0004]

Swales has been further cited for supporting the teaching of **Omshehe** for industrial automation system [industrial automation systems market, there are various types of communications network protocols which were developed for products, such as PLCs, to run on the products to be networked together, and for the field devices to be monitored and controlled from various locations within the particular automation systems, Col. 1, lines 23 – 32] for the purpose of communication between devices. [Col. 1, lines 23 – 41 and Abstract]

It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teaching of **Omshehe** to include "automation" with the

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motivation being to provide for the purpose of communication between devices [Col. 1, lines 23 – 41 and Abstract].

Regarding Claim 5

Omshehe teaches, components are connected by radio communication and/or by a fixed link to the process control computer. [Fig. 1]

Omshehe does not teach the field devices for monitoring and control of components of a technical system and the further operations are initiated in further components of the process control system.

Swales teaches the field devices for monitoring and control of components of a technical system [Col. 1, lines 23 – 32] and the further operations are initiated in further components of the process control system [Col. 1, lines 23 – 32].

Regarding Claim 6

Omshehe does not teach communication is based on the TCP/IP transmission protocol (TCP/IP).

Swales teaches communication is based on the TCP/IP transmission protocol (TCP/IP). [Col. 1, lines 23 – 41 and Col. 3, lines 50 – 53]

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Regarding Claims 10, 12 and 13

Omshehe teaches,

- the payment figure is a service fee to be paid by the user of the process control system to an Application Service Provider. [properly charging customers for their use of such portal services, 0010; a new way to monitor and regular access by users to manufacturing/process control portal services, 0011]

Response to Amendment

Priority

5. The Prior-Filed Nonprovisional Application has been Improperly Indicated as a National Stage (35 U.S.C. 371) Application (The document mailed to applicants on April 29th, 2004) priority has been indicated improper hereinafter. Further, a claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application in chain by the PCT, since the PCT was filed more than seventeen months before current application thereafter.

Claim Rejections - 35 USC § 102 & 103

6. The examiner disagree the arguments in the appeal brief filed by the application on November 29th, 2006. Yet, **Omshehe** reference is a good reference for teaching “providing Web access to a process control network, significant challenges are faced with regard to regulating access to the process control network information and resources as well as to

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properly charging customers for their use of such portal services” similar with applicants’ invention, thus, the examiner withdraws the forth rejections and cited new sets of rejections based on **Omshehe** reference and **Swales** reference in current office action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunray Chang who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. via telephone number (571) 272-3682 or facsimile transmission (571) 273-3682 or email sunray.chang@uspto.gov.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Anthony Knight can be reached on (571) 272-3687.

The official facsimile transmission number for the organization where this application or proceeding is assigned is (571) 273-8300.



Anthony Knight
Supervisory Primary Examiner
Group Art Unit 2121
Technology Center 2100
U.S. Patent and Trademark Office

February 8, 2007